IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Examiner: Weisberger, Richard
TRAN	Art Unit: 3624
Application No.: 09/842,599	
Filed: 4/25/2001	
For: SYSTEMS AND METHODS FOR TRADING INTELLECTUAL PROPERTY	**APPEAL BRIEF**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant offers this Appeal Brief and the Notice of Appeal filed herewith for the
above-referenced patent application. Appendix A, attached hereto, contains a clean copy
of all claims pending in this case.

REAL PARTY IN INTEREST

All right, title, and interest in the subject invention and application are assigned to
Available for Licensing (AFL), San Jose, CA 95135. Therefore, AFL is the real party
interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be
directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-20 were originally presented in the application. Claims 1, 17 and 20 were amended; claims 2-15 were canceled and claims 21-34 were added. Claims 1 and 16-34 are the subject of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

A first Office Action was mailed in April 2007 and claims 1, 17 and 20 were amended. Claims 2-15 were canceled and claims 21-34 were added. A Final Office Action was mailed on 10/5/2007. A Notice of Appeal is filed herewith. A clean copy of all the pending claims is provided in Appendix A, attached hereto.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to systems and methods that cost-effectively facilitate and enhance the licensing and trading of IP assets. The system supports purchasing or selling of intellectual property related products and services with a computerized bid, auction and sale system over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP. The techniques support a service-based auction network of branded, online auctions to individuals, businesses, or business units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology (page 2, lines 15-22).

Claim 1 relates to a system to support trading of intellectual property (IP) with a processor (page 2, lines 24-27, Fig. 1); a user interface displayed by the processor to accept a request to trade an IP asset (page 2, lines 24-27 and lines 29-30, Fig. 1); a user interface displayed by the processor to store information on the IP asset including rating information (page 2, lines 24-27, Fig. 1); and a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset (page 2, lines 24-27, Fig. 1).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

    I.   Whether claims 1 and 16-34 are properly rejected under Section 112.

    II.   Whether claims 1 and 16-34 are patentable over Riodan.

ARGUMENT

    I.   CLAIMS 1 AND 16-34 COMPLY WITH SECTION 112

Claims 1 and 16-34 were rejected under 35 U.S.C. 112, first paragraph. Applicant respectfully traverses the rejection. Claim 1's language is supported on page 12. Claims 16 and 18-20 were originally filed in the application and thus not new subject matter. Claims 17 and 21-29 are supported by pages 3-4 of the Specification. New claims 30-31 are supported by pages 7-8 of the Specification. New claim 32 is supported by page 12 of the Specification. New claims 33-34 are supported by page 13 of the Specification. Addressing the claims one by one:

Claim 1's "user interface comprising rating information" is discussed in the paragraph around page 12, line 30 and thus is supported by the specification.

As to claim 17, page 3, line 10 shows that the parties can list and search for applications that are near abandonment. Although the language of "about to be abandoned" was revised to address a prior Section 112 rejection, one skilled in the art would know that applications are about to be abandoned covers applications that are within a predetermined period from abandonment.

Claims 16 and 18-20 were originally filed with the application and are *per se* supported.

As to claim 21, page 3, lines 25-30 and page 9, lines 21-24 teach that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service.

As to claim 22, page 3 lines 26-28 shows that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As to claim 23, page 3, lines 28-30 shows that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

As to claim 24, page 4, lines 3-9 shows that the PIM provides the user with access to a social network.

As to claim 25, page 4, lines 3-9 shows that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

As to claim 26, page 4 lines 14-15 shows that the PIM displays advertisements for a predetermined period of time.

As to claim 27, page 17, line 10 and page 1 line 23 show that the PIM allows an inventor to file a patent application with a patent office.

As to claim 28, page 17 line 10 shows that the PIM allows an inventor to file a patent application.

As to claim 29 page 3 line 19 and page 4 lines 7-10 show that the PIM automatically updates the user on any new IP in the user's areas of interest.

As to claim 30 page 6 line 27 and page 7 lines 22-31 show that the PIM provides an appraisal of the IP.

As to claim 31 page 8 lines 15-28 shows that the PIM provides escrow to facilitate an IP transaction.

As to claim 32, page 12 lines 26-31 shows that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

As to claim 33, page 13 lines 1-6 shows that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

In sum, the claims are supported under the first paragraph of Section 112. Withdrawal of the Section 112 rejection is requested.

Claims 1 and 16-34 were also rejection under Section 112 second paragraph. As to claim 1, the user interface displayed by the processor to store information on the IP

asset including rating information is definite and limits the claim. Further, the phrase "parties can list within a predetermined period from abandonment" is definite. Withdrawal of the rejection under Section 112 second paragraph is requested.

In sum, all claims are supported by the Specification. Withdrawal of the Section 112 rejection is requested.

II.   CLAIMS 1 AND 16-34 ARE PATENTABLE OVER RIODAN.

Claims 1 and 16-20 were originally rejected under 35 U.S.C. 102(a) as anticipated by Riodan, NY Times article. The Final Office Action raised a Section 103 Rejection on all claims over Riodan. The Office Action took official notice that each module of claims 1, 17 and 21-34 are known in the art.

Applicant respectfully traverses the rejection. Here, the rejection is improper since the prior art reference relied upon by the examiner in a § 103 rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim. Nowhere in Riodan does it show the claimed specifics of a system to support trading of intellectual property (IP) with a user interface displayed by the processor to accept a request to trade an IP asset; a user interface displayed by the processor to store information on the IP asset including rating information; and a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset. Withdrawal of the rejection is requested.

In the instant case, the Examiner has not provided <u>any</u> rationale or evidence in the reference proving that Riodan shows the processor and the database. Withdrawal of all rejections is requested.

Here, the suggestion arises from hindsight as taught by the instant application. Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

As discussed above, there is no suggestion to modify Riodan to arrive at the invention as claimed. There is no reasonable expectation of success since Riodan does not even address IP rating information. Finally, Riodan, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Riodan, there is an inference that it came from Applicants' disclosure. Thus, Riodan cannot render obvious the independent claim and those claims dependent therefrom.

Moreover, dependent claims are allowable since Riodan does not show the specifics as recited in the dependent claims as follows:

As for claim 16, Riodan fails to show the claimed online platform for selling and buying patentable ideas or pending patent applications.

As for claim 17, Riodan fails to show the claimed parties can list and search for applications that are within a predetermined period from abandonment.

As for claim 18, Riodan fails to show claim 1 where the network is the Internet and wherein clients access the system using a browser.

As for claim 19, Riodan fails to show the claimed a patent information management (PIM) system to display information for a user to manage the user's IP and to communicate with other users relating to the IP.

As for claim 20, Riodan fails to show that the PIM provides information on pending activities relating to an IP asset and wherein the user drills down to get additional information on the IP asset.

As for claim 21, Riodan fails to show that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service.

As for claim 22, Riodan fails to show that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As for claim 23, Riodan fails to show that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

As for claim 24, Riodan fails to show that the PIM provides the user with access to a social network.

As for claim 25, Riodan fails to show that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

As for claim 26, Riodan fails to show that the PIM displays advertisements for a predetermined period of time.

As for claim 27, Riodan fails to show that the PIM allows an inventor to file a patent application with a patent office.

As for claim 28, Riodan fails to show that the PIM allows an inventor to file a patent application.

As for claim 29, Riodan fails to show that the PIM automatically updates the user on any new IP in the user's areas of interest.

As for claim 30, Riodan fails to show that the PIM provides an appraisal of the IP.

As for claim 31, Riodan fails to show that the PIM provides escrow to facilitate an IP transaction.

As for claim 32, Riodan fails to show that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

As for claim 33, Riodan fails to show that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

As for claim 34, Riodan fails to show that the PIM supports user-generated IP content.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under <u>no</u> obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to <u>any</u> evidence in Riodan, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of independent claim 1. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability …. the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Marsh reference, or knowledge of those skilled in the art, for modifying Riodan to arrive at claims 1 and those dependent therefrom, *prima facie* obviousness of these claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of all claims be withdrawn and the claims be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

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APPENDIX A

CLAIMS

1. A system to support trading of intellectual property (IP), comprising:

a processor;

a user interface displayed by the processor to accept a request to trade an IP asset;

a user interface displayed by the processor to store information on the IP asset including rating information; and

a database coupled to the user interface and to the processor to store data. associated with one or more IP assets, the database supporting the trading of the IP asset.

2-15 (Canceled).

16. The system of claim 1, further comprising an online platform for selling and buying patentable ideas or pending patent applications.

17. The system of claim 16, wherein parties can list and search for applications that are within a predetermined period from abandonment.

18. The system of claim 1, wherein the network is the Internet and wherein clients access the system using a browser.

19. The system of claim 18, further comprising a patent information management (PIM) system to display information for a user to manage the user's IP and to communicate with other users relating to the IP.

20. The system of claim 19, wherein the PIM provides information on pending activities relating to an IP asset and wherein the user drills down to get additional information on the IP asset.

21. The system of claim 19, wherein the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service.

22. The system of claim 19, wherein the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

23. The system of claim 22, wherein the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

24. The system of claim 19, wherein the PIM provides the user with access to a social network.

25. The system of claim 19, wherein the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

26. The system of claim 19, wherein the PIM displays advertisements for a predetermined period of time.

27. The system of claim 19, wherein the PIM allows an inventor to file a patent application with a patent office.

28. The system of claim 19, wherein the PIM allows an inventor to file a patent application.

29. The system of claim 19, wherein the PIM automatically updates the user on any new IP in the user's areas of interest.

30. The system of claim 19, wherein the PIM provides an appraisal of the IP.

31. The system of claim 19, wherein the PIM provides escrow to facilitate an IP transaction.

32. The system of claim 19, wherein the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

33. The system of claim 19, wherein the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

34. The system of claim 19, wherein the PIM supports user-generated IP content.

EVIDENCE APPENDIX

      NONE

RELATED PROCEEDINGS APPENDIX

      NONE